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EXAMINER

ALIE, GHASSEM

ART UNIT PAPER NUMBER

3724

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/031,671	<b>Applicant(s)</b> GROSS ET AL	
	<b>Examiner</b> Ghassem Alie	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.  
4a) Of the above claim(s) 23-25 and 27-30 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 18-22, 26 and 31-34 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/26/04&amp;01/17/02</u> . | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election with traverse of Species C on 07/20/04 is acknowledged. The traversal is on the ground(s) that that independent claim 18 is generic to Species C and D. Applicant's traverse is misplaced. Clearly, different species are claimed and each species as identified by the Examiner is patentably distinct from each other. Generic claims permit rejoinder of a reasonable number of claims if one or more generic claims are found to be allowable. However, applicant's independent claim is not generic to both Species C and D. In order to be generic a claim must comprehend within its confines the organization covered in each of the species. This is not possible here. For example, Species C has an adjusting element which is a ruler and Species D has an adjusting element which is in a form of a sheet. While the broad claims may be broad enough to encompass several species they are not generic as defined by MPEP 806.04(D). Nevertheless, if an independent or superior claim that encompasses other claimed species is allowed; rejoinder will be permitted as long as there is compliance with respect to 35 U.S.C., 2<sup>nd</sup> paragraph.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 23-25 and 27-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made traverse on 07/20/04.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937,

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214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 18-20, 26, 31-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15, 17, 19, 22, 25, 26, and 28 of copending Application No. 10/031,669 and over claims 15, 17-19, 22, 25, 26, and 28 of copending Application No. 10/031,817. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 18-20, 26, 31-34 are anticipated. With respect to claim 18, claims 15, 22, and 25 of the copending Application No. 10/031,669 and 10/031,817 read over claim 18. With respect to claim 19, the hollow die-cutter blade inherently has at least one knife edge portion. With respect to claim 26, the frame includes a closed portion since the first and secondary clamping means are retained between the parallel lateral legs and are in parallel position with respect to the short legs of the frame.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 21 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15, 22, 25, and 26 of copending Application No. 10/031,699 or 10/031,817, in view of Terasaka (3,982,458) or Wallis (4,665,733). Regarding claims 21 and 22, copending applications above teaches

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everything in claims 15, 22, 25, and 26 except that the adjusting ruler is positioned parallel to an edge of the frame which is mounted to the punch and the adjusting ruler is located between the die-cutter blade and the frame opposite the leading edge of the die-cutter blade. However, the use of adjusting ruler which is positioned parallel to the frame which is holding the die-cutter blade is well known in the art such as taught by Terasaka or Wallis. Terasaka teaches an adjusting ruler 26, 39 which is positioned parallel to the frame 18 and is located between a die-cutter blade 17 and the frame opposite the leading edge of the die-cutter blade 17. The shaft 26, 39 inherently is also used as an adjuster ruler, since it is capable of facilitating the alignment of the knife portion of the die-cutter blade with respect to the frame. See Figs. 1-4 and col. 2, lines 16-62 in Terasaka. Wallis also teaches an adjusting ruler 124 which is positioned parallel to the frame 18 and is located between a die-cutter blade 16 and the frame 18 opposite the leading edge of the die-cutter blade 16. The shaft or rod 124, 39 inherently is also used as an adjuster ruler, since it is capable of facilitating the alignment of the knife portion of the die-cutter blade with respect to the frame. See Figs. 1-2 and col. 4, lines 11-61 in Wallis. It would have been obvious to a person of ordinary skill in the art to provide adjusting ruler of either of copending Application's die-cutter with location and alignment capability as taught by Terasaka or Wallis in order to facilitate the alignment of the die-cutter blade with respect to the frame.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 18-22, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terasaka. Regarding claim 18, Terasaka teaches a device for die-cutting a stack of sheet materials including a hollow die-cutter blade 17 and a frame 12 for receiving and retaining the die-cutter blade 17. Terasaka also teaches that the die-cutter blade is adjustable relative to the frame 12 and it is fixed to the frame with clamping means 50. Terasaka also teaches an adjusting element 26, 39 mounted in the frame for facilitating alignment of the at least one knife edge portion of the die-cutter blade 17 with respect to the frame 12. The shaft 26, 39 which provides the sliding mechanism for the holding means 18 and consequently adjust the position of the die-cutter blade and its knife portion edge with respect to the frame 12. Terasaka also teaches a cylinder or 13 and a moveable ram 14 for engaging a stack of material and pressing the sheet of materials into the die-cutter blade, wherein an initial position of the frame 18 is maintained with respect to the cylinder during operation of the moveable ram 14. See Figs. 1-4 and col. 2, lines 16-62 in Terasaka. The die-cutter 17 appears to be hollow in Terasaka. However, the use of the hollow die-cutter blade is well known in the art such as evident by Maschinot (3,741,057). The shaft 26, 39 are capable of being used for alignment. However, the use of alignment device which is mounted to a holding frame is well known in the art as is evident by Gaither et al. (3,113,515), hereinafter Gaither.

Regarding claims 19 and 20, Terasaka teaches everything noted above including that the knife edge portion includes a leading knife edge portion of the die-cutter blade 17.

Terasaka also teaches that the adjusting element 26, 39 is a ruler. The shaft or rod 26, 39 is

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also defined as a ruler. In addition, the adjusting element which is a ruler is well known in the art as is evident on Gaither. The index 50 is defined as a ruler in Gaither. See Fig. 1 in Gaither.

Regarding claim 21, Terasaka teaches everything noted above including that the adjusting ruler 26, 39 is positioned parallel to an edge of the frame 12. Terasaka does not teach that the frame 12 is mounted to a punch platen. However, the upper die 16 is connected to a punch platen 76. However, It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lower die-cutter blade with the punch platen rather than the upper die-cutter, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Regarding claim 22, Terasaka teaches everything noted above including that the adjusting ruler 26, 39 is located between the die0cutter blade and the frame opposite the leading edge of the die-cutter blade 17. See Fig. 1-3 in Terasaka.

Regarding claim 31, Terasaka teaches everything noted above including that the punch platen 76 and a receiving apparatus 15 adjustably mounted to the punch platen 76 where receiving means receives and retains the frame 12. The connector 15 is defined as a receiving means which retains and receives the frame 12, which is exchanged with the frame 11. The receiving apparatus is adjustable with respect to the punch platen 76 by the mounting screw as shown in Fig. 7 in Terasaka. See Figs. 1 and 7 in Terasaka.

Regarding claim 32, Terasaka teaches everything noted above including that the receiving apparatus 15 includes two parallel gibs 75 which accept the frame 12. The elements

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75 are considered to be gibs.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Terasaka in view of Ames (958,459). Regarding claim 26, Terasaka teaches everything noted above except that clamp has a clamping beam and the die-cutter blade is retained between one of pair of parallel legs of the frame portion and the clamping beam. However, Ames teaches a clamping beam 20 and a die-cutter blade 36 which is retained between one of the parallel legs 15 of a frame and the clamping beam 20. See Fig. 1 in Ames. It would have been obvious to a person of ordinary skill in the art to provide Terasaka's frame and clamping means with the parallel legs and clamping beams such as taught by Ames as an alternative way to hold the die-cutter blade which works the same as the Terasaka's die-cutter holder mechanism.

#### *Comment*

9. Claims 33 and 34 have not been rejected over prior art, since the prior art does not teach that frame is tiltable with respect to the plane and is adjustable with respect to both orthogonal plane axes as set forth in claim 33. However, the allowability of claims 32 and 33 cannot be indicated at this time due to the issues with the obviousness-type double patenting as set forth on paragraph 4 above.

#### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gaither et al. (3,113,515), Schnell et al. (5,715,275), Wallis (4,665,733), Blumer (5,183,247), Macchinot (3,741,057), Brestel et al. (3,290,977 and 3,468,200), Wegener



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(6,324,951), Neumann et al. (5,460,479), Jenkner (4,911,281), Long et al. (6,389,940), Schneider (3,546,990), Noell (2,495,659) and (2,483,735), Donnerberg et al. (2,220,056), Molison (6,055,896), Busch (3,479,914), Fellner (4,187,713), and Bruehwiler (5,768,963) teach a die holder device having a clamping mechanism.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (703) 305-4981. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (703) 305-1082. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9302 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

GA/ga

September 1, 2004

  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700